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EXAMINER

WEINSTEIN, STEVEN L

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1761

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/940,805
Filing Date: August 29, 2001
Appellant(s): STACHOWICZ ET AL.

Zeba Ali
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/20/06 appealing from the Office action
mailed 7/26/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

NEW GROUND(S) OF REJECTION

Claims 1-12 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shannon ('238), as further evidenced by Janik (EP'132), in view of Craig (GB '224), Schultz et al ('809), Ekdahl ('111), Lacey ('262), Loucony ('533), Setecka ('458), and Hueg (' 719), further in view of Ooms (EP '006), Berrod (FR '674),

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Parrish et al ('523), Weschler ('496), Delorimiere ('917), Moore ('654), Knight ('165) Niggemeyer ('584), appellants' admission of the prior art and newly cited Hawley ('013).

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

The one and only rejection set forth in the Final Rejection mailed 7/26/06 is withdrawn in favor of the new ground of rejection stated above. Note, however, that this new ground of rejection is the same rejection, employing the same references for the same reasons, as found in the Final Rejection of 7/26/06, except for the addition of Hawley.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,153,238	SHANNON	11-2000
EP340,132	JANIK (EUROP.)	11-1989
GB2,237,224	CRAIG(G. BRITAIN)	5-1991
3,191,809	SCHULTZ et al	6-1965
2,103,111	EKDAHL	12-1937
2,968,262	LACEY	1-1961
2,928,533	LOUCONY	3-1960
2,945,458	SETECKA	7-1960
560,719	HUEG	5-1896

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EP757,006	OOMS (EUROP.)	2-1997
FR598,674	BERROD (FRANCE)	3-1925
3,847,523	PARRISH et al	11-1974
2,320,496	WECHSLER	6-1943
4,844,917	DELORIMIERE	7-1989
2,419,654	MOORE	4-1947
6,179,165	KNIGHT et al	1-2001
2003/0205584	NIGGEMYER	11-2003

Appellants' admission of the prior art.

Newly Cited Evidence Relied Upon

5,104,013	HAWLEY	4-1992
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Full translations of both Berrod and Janik have been included and mailed. The references are being applied for the reasons previously given.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-12 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shannon ('238), as further evidenced by Janik (EP'132), in view of Craig (GB '224), Schultz et al ('809), Ekdahl ('111), Lacey ('262), Loucony ('533), Setecka ('458), and Hueg (' 719), further in view of Ooms (EP '006), Berrod (FR '674), Parrish et al ('523), Weschler ('496), Delorimiere ('917), Moore ('654), Knight ('165) Niggemeyer ('584), appellants' admission of the prior art and newly cited Hawley ('013).

It is first noted that Shannon discloses two embodiments. In one embodiment, Shannon discloses what appellants refer to as a decorative tip, having what appellants refer to as a non-circular opening. For example, fig.4, element 40 of Shannon is the decorative tip, with the elements 43,44, (in appellants' terms), making the outlet opening noncircular. Shannon also discloses another embodiment including, (in appellants' terms), a "coupler" (e.g. fig.5, element 141), which enables it to be coupled to another structure, and wherein the coupler has an inlet end and an outlet end.

With this in mind, in regard to claim 1, Shannon discloses a coupler (#141) for insertion into a bag fabricated to hold filling, comprising a hollow shaft having a non-decorative opening for receiving filling (i.e., the wider inlet opening at the left in the figures), and a tip extending from and integral with the hollow shaft (i.e., the outlet at the right in fig. 5 and 6), and means provided on an exterior of the shaft to engage a decorative tip capable of extruding filling in a shape different from the coupler. Shannon discloses the means to engage a decorative tip are screw threads, which is appellants' disclosed means. Claim 1 recites that the coupler is a "decorator" coupler and the "decorative" tip has a "non-circular" opening. It is first noted that the terms "decorator" and "decorative" are functional, usage-type terms. That the coupler (#141) of the fig. 4/5 embodiment of Shannon, with its round cross-sectional outlet opening, by itself, without element #145, is capable of being called a "decorative" tip, and is capable of extruding filling in a "decorative" shape, is evidenced by Craig (fig. 3), Schultz (35b), Ekdahl (fig. 3), Lacey (fig. 2), Loucony (fig. 1), Setecka (23b), and Hueg (fig. 1). All of these references teach nozzle or extruder openings that can have round or circular cross-

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sectional outlet openings, and produce cylindrical material used as decorations. These references had been applied during the course of prosecution in response to urgings that a smooth, circular opening, which would produce a smooth cylindrical ribbon, would not have been considered a "decorative" tip in the art. The preponderance of the art, taken as a whole, evidence the fact that this urging was inaccurate. It is also noted that the phrase "non-circular", is not further clarified as to direction or orientation, so that it would be debatable as to whether even appellants' disclosed dentate design (also shown by Shannon) would necessarily meet the phrasing "non-circular". For example, when viewing a dentate opening head-on, it would still appear that the opening is circular as in a circular array of teeth-like projections and even the product extruded from such an opening could be termed a corrugated, cylindrical shape. In any case, to modify the "coupler" embodiment of Shannon and provide the coupler element (which enables it to couple with other, differently sized or shaped outlets) with a non-circular opening, if necessary, rather than a circular opening (which would enable it to extrude a corresponding shape if employed alone), would have been an obvious matter of design (i.e., shape). This is because, as evidenced by Shannon's other embodiment, shown in figure 4, as well as Janik, Craig, Schultz et al, Ekdahl, Lacey, Loucony, Seteckka, Hueg, Ooms, Berrod, Parrish et al, Wechsler, Moore, Knight et al and appellants' admission of the prior art, it was, of course, notoriously conventional to provide extruder outlets for food decorating with non-circular openings. The art taken as a whole teaches that these extruder outlets, referred to as decorator tips, can be pre-fitted for immediate use as shown e.g., by Shannon and Janik, or attached to a coupling element such as shown,

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e.g., by Shannon and Parrish et al. Also, Knight et al discloses that a coupling element could be used to directly extrude product from a bag without the so-called decorative non-circular tip added thereto as evidenced by Fig. 1 of Knight et al. Knight et al describes fig. 1 as showing the pastry bag construction "in use" (and fig.3 as showing the engagement of an "optional" decorative nozzle accessory). Therefore, since the art taken as a whole teaches one can provide a coupling which has circular openings and coupling means and would be capable of immediate use by itself to extrude a cylindrically shaped product, and since the art taken as a whole teaches extruder outlets which are arranged for immediate use or are arranged to be coupled are also known which are non-circular, and since the art taken as a whole teaches it was known to use a coupling element without an extra extruder outlet, to modify the coupler of Shannon by employing a non-circular cross sectional shaped extruder outlet to enable it to produce a shape corresponding to the shape of the outlet, rather than a circular shaped cross-sectional outlet opening, would therefore have been obvious in view of the art taken as a whole. As disclosed, appellants' reason for providing a coupling element with a non-circular outlet opening is to provide the bag with immediate decoration producing capability while also allowing one to change outlets to impart different shape capability. However, the art taken as a whole is seen to fairly teach this result for the reasons given above. That is, the art teaches the ability to produce an immediate shaped product whether it is a coupler or not, and the art also teaches coupling means to add differently shaped outlets, and the art also teaches that one can extrude all types of shapes and sizes of food material as decorative elements including circular or non-circular shapes.

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The art taken as a whole also teaches that appellants are not the first to provide structure which allows one to change the shape or size of an extruded product by positioning or associating one die opening over another as evidenced by Ekdahl (p.2, col.1, para.4) and newly cited Hawley. Although newly cited Hawley discloses caulking, Hawley nevertheless discloses it was conventional to provide a plurality of thread containing extruder nozzles or tips having differently sized outlet openings so that one nozzle could be associated with another to change an aspect of the extruded material, i.e. its size. Each thread containing, extruder nozzle is a coupler for an extruder nozzle of a different size that is to be coupled with the first one to change the size of the extruded material. Hawley even teaches that the extruder nozzle that originally comes positioned in the casing is self threadable with one of the additional nozzles so that the outlet opening of the initial extruder nozzle can be changed by screwing differently sized nozzles thereon.

In regard to the other embodiment in Shannon (i.e., fig. 3 or fig. 7), wherein an extruding element is present which is arguably non-circular and is referred to by appellant as decorative tip, claim 1 differs from this embodiment of Shannon in that the decorator tip does not contain coupling means (i.e. threads) for coupling other, differently shaped outlets, extruder nozzles/tips. To modify this embodiment of Shannon and provide the so-called non-circular tip with thread-type, coupling means so that one could employ the tip for immediate use (as taught by Shannon and the art taken as a whole), but also have the capability of employing differently shaped openings to produce differently shaped/sized products as also taught by Shannon and the art taken

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as a whole would have been obvious for its art recognized and appellants intended function. As fully discussed above, the art taken as a whole discloses that it was conventional to provide a bag with a decorator tip having one of a plurality of conventional, variously shaped cross-sectional outlets to allow one to immediately start decorating without additional manipulations; that it was conventional to provide a bag with a plurality of decorator tips for incision into the bag individually as needed with each one having a differently shaped cross sectional outlet for interchangeability with each other; and it was conventional to provide threaded coupling means on a conduit or channel for use in a bag to provide one with the ability to impart various shapes and not be left with only one choice in shape or size by easily and quickly screwing on the shaped tip or nozzle of ones choice onto the coupler and unscrewing one tip and screwing on another tip as desired. Note that the structural elements of Shannon to be associated with the bag in both of Shannon's two embodiments, whether it has a non-circular, cross-sectional outlet without fastening means or a circular, cross-sectional outlet with fastening means, both have in common that they are conduits and allow the food product to pass through. Shannon and the art taken as a whole discloses that if one desires to provide a choice in decorative design, rather than just switch tips, one should provide the interior element/conduit with threaded coupling means to couple a second, differently shaped or sized cross-sectional outlet element thereto.

In regard to dependent claims 2-4, the art taken as a whole discloses the conventionality of screw threads and retaining nuts (e.g., Shannon fig. 5), a tapered coupler, and a coupler with a shoulder (Shannon #142), respectively. In regard to claims

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5-10, claim 5 recites the coupler discussed above in combination with a bag and retainer nut. Shannon in view of the art taken as a whole discloses it would have been obvious to associate a conventional flexible bag having a coupler with a non-circular opening and means (i.e., threads) to couple with a decorative tip for the reasons fully detailed above. The art taken as a whole, including Shannon, teaches the conventionality of a bag pre-filled with filling (claim 10) and made of plastic (claim 8). In regard to the method claims 11,12 and 14, it would have been obvious to provide a shaped opening, coupler with a nozzle tip if one were wanted to provide the user with a variety of shapes for the reasons given above. In regard to claims 16-20, the particular conventional, cross-sectional shape of the outlet is seen to have been an obvious matter of choice as evidenced by their well documented use in the art as evidenced by the art taken as a whole. DeLorimiere is relied on as further evidence of the conventionality of providing a threaded nozzle within a bag and that diverse nozzle tips can be employed to permit extrusion and dispensing of the frosting material in desired shapes (col. 4, para. 3). Niggemeyer is further evidence of the conventionality of an extruder nozzle or a coupler within a bag. Note in this regard that the Court has noted in *In re Gorman* (18USPQ2d,1888), that "where teachings relied upon to show obviousness were repeated in a number of references, the conclusion of obviousness was strengthened".

(10) Response to Argument

All of appellants' remarks filed with the Brief have been fully and carefully considered but are not found to be convincing.

On page 4 of the brief, it is urged that there is no motivation to substitute a non-circular opening for the circular opening of Shannon and that making it non-circular runs counter to Shannon's intended function. This urging is directed to the first rejection detailed above, wherein the rejection states it would have been obvious to modify the threaded coupler and change the shape of the cross-sectional outlet. The reasons for combining the references are fully and clearly detailed above. As discussed in detail above, since the art taken as a whole teaches that it was known to provide couplers in a pastry bag, that it was known to provide decorative nozzles in a pastry bag for immediate extruding, that it was known to employ either a nozzle or a coupler in the bag, that it was known that extruding nozzles can have any shape including circular or non-circular cross-sections, and it was known to employ a coupler to extrude icing with/without an additional nozzle, to provide the coupler with a decorative opening (circular or not) for its art recognized and applicants intended function is seen to have been an obvious matter of choice and/or design. Knight which teaches extruding the material directly through the coupler (which has a narrow opening see fig 2) is sufficient evidence that another nozzle is only necessary if a different shape is desired and the art taken as a whole clearly evidences one can employ any shape desired as a function of the design desired.

Note, too, that Shannon would not have to teach employing the coupler by itself, to provide a shaped product, without an additional attached nozzle, for the rejection to

be proper. Although there appears to be sufficient teaching in Shannon itself to modify the coupling and provide a different shape or size output in view of Shannon's other embodiment, the secondary art can, in any case, be relied on to teach both the problem and its solution. That is, the art teaches that any conduit can impart a shape to an extruded product by providing the outlet opening of the conduit with the appropriate shape, that one can provide outlet nozzles with threads to attach other differently shaped or sized nozzles thereto, and that a coupler can be used as the outlet opening without an attached additional, differently shaped outlet element. Appellants refer to the Declaration filed by Mr. Wurster on 4/26/06 to support their urging that the combination would not have been obvious.

The Declaration filed by Mr. Wurster, under 37CFR 1.132, on 4/26/06, had been fully and carefully considered but was not found to be sufficient to overcome the prima facie case of obviousness set forth in the rejection. The Declaration was devoid of factual evidence, merely stating opinions. The Declaration was also not commensurate in scope with the claims nor did it address the rejection. The rejection states that it would have been obvious to provide a non-circular decorative tip with means to accept and secure other decorative tips to provide the user with greater choice of designs or it would have been obvious to modify the circular outlet coupler, which already has a means to accept and secure decorative tips, by providing a non-circular outlet; all in view of the art taken as a whole. The art, taken as a whole, teaches providing the outlets of extruder bags with screw threads to allow the bag to have various shaped extruder nozzles attached to it so that there is much greater flexibility or variation in the

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shape of the extrudate. Note that even the so-called non-circular decorative tip is a bag outlet. The art, taken as a whole, also teaches that a circular outlet is still considered a decorative nozzle, so that a so-called coupler with a circular outlet opening is still capable of being used as a decorative nozzle. Thus, when one attempts to make a distinction between a non-circular decorative tip (which is, after all, in reality or functionally, a nozzle outlet), and a coupler which has a circular outlet, (which will produce a round, cylindrical ribbon which the art considers to be a decorative shape), one is urging (incorrectly) intended use capability when the difference is truly and merely a matter of shape (i.e. design).

The Declaration urged that Shannon's coupler shows a circular opening that is substantially larger than the opening of the attached decorative tip. The Declaration further urged that, based on the Declarant's knowledge, the reason the opening is larger is so that the material will flow with minimum resistance from the bag through an attached tip. Declarant then concludes that, in Declarant's opinion, one would not be motivated to modify the large circular coupler opening to the non-circular coupler opening, presumably because one would expect a non-circular opening to cause an unduly greater resistance to flow and there would be no reasonable expectation of success. This whole line of reasoning/opinion is not convincing since there appears to be no significant difference in size between Shannon's non-circular nozzle (40) employed by itself, without an adaptor/coupler, and Shannon's circular, threaded adaptor/coupler (141). In fact, the nozzle (40), which is disclosed as the element that is directly attached to the bag, and directly extrudes the material, appears, if anything, to

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be slightly larger than the adaptor/coupler. Therefore, Shannon teaches a working extruder/decorative nozzle with a large opening that is non-circular, so that it is not seen why an increase in resistance to flow, if any, caused by a non-circular opening would be significant and it is therefore not seen why one of ordinary skill in the art would not have had a reasonable expectation of success. Appellants have provided an exhibit, which is the drawings of figures 4 and 5 of Shannon, in an attempt to show that the coupler (141) of Shannon is larger than the decorative tip (40) of Shannon. The comparison is not accurate since appellants have chosen to use the most narrow outlet opening ("d") of the decorator tip of Fig. 4 but use the widest dimension ("D") of the coupler of Fig. 5, which includes the thickness of the wall. As shown in fig. 6, the outlet is narrower than the "D" cross-section. The issue is moot in any case, since the drawings are not necessarily to the same scale so that accurate comparisons are not really possible. The issue of size is further irrelevant since one could very clearly employ a wider bead as a border for example, which border would still be a decorative element. Therefore, to urge that size matters, at least in this case, is not convincing. Finally, in this regard, and as discussed above, in the body of the rejection, appellant is not the first to teach using a coupler element (that has means to couple or attach a decorative tip thereto) by itself without the decorator tip. Finally, note that neither the Declaration nor the remarks addressed the issue previously raised during prosecution as to why the recitation "non-circular" need necessarily exclude a nozzle with say a zig-zag rim around its circumference. Note that neither the Declaration nor the arguments addressed the fact, set forth previously, that the art taken as a whole teaches that a solid cylindrical

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extrudate, produced from a circular outlet, is still a decorative shape so that a circular outlet would inherently be called or at least be capable of functioning as a decorator tip/nozzle. Whatever one chooses to call the attachment, based on its intended use or otherwise, the attachment is still an outlet for a bag to allow material to be extruded therethrough, and the art taken as a whole teaches one can add threads or other securing means onto the attachment element to attach additional attachment elements thereto to vary the shape of the extruded material in an easy manner. There therefore is no unexpected result. It is also not clear that reciting a non-circular decorative tip even excludes a zig-zag pattern on an otherwise circular outlet. Finally, it is noted that any urging relative to size of coupler opening versus size of decorative tip opening is directed to limitations not found in the claims since the claims are silent in this regard. However, as noted above, even if such sizes were recited, in view of the art, taken as a whole, any urging in this regard would not be convincing.

On page 6 of the Brief, the Brief states what each of claims 7,11,12,16, and 17 recite and then states that the "additional limitation is not described by Shannon in combination with the other references". It is not clear what this means. In any case, as detailed above, either Shannon by itself, or in combination with the art taken as a whole, discloses that it would have been obvious to provide a second decorative tip, attachable to the coupler with a nut; push filling through a non-circular opening of a coupler, and provide a decorative tip with dentate protrusions.

In summary, and as discussed in detail above, since the art taken as a whole teaches that it was conventional to provide threaded couplers in a pastry bag so that

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differently shaped nozzle outlets could be attached for greater flexibility in the decorations to be made, that it was conventional to provide decorative nozzles either already in a pastry bag for immediate extruding or to be inserted into the bag, that it was conventional to employ either a nozzle or a threaded couple in the bag, that it was conventional to provide extruding nozzles with any shape one desires, including circular or non-circular cross-sections, that it was conventional to employ coupler threads on nozzles so that additional threaded nozzles, having different outlets, can be coupled to the threaded, coupler nozzle (e.g. Hawley), and it was conventional to employ a threaded coupler to extrude icing with/without an additional nozzle, to either provide the threaded coupler of Shannon with a decorative opening (circular or not) or provide the so-called, non-circular, decorator tip of Shannon with threads for attaching other shaped nozzles to give the consumer more flexibility in the decoration, i.e., in both cases, for its art recognized and applicants intended function is seen to have been an obvious matter of choice and/or design.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte dismissal of the appeal* as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

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Respectfully submitted,

Steve Weinstein
STEVE WEINSTEIN 1761
PRIMARY EXAMINER

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:


GREGORY MILLS
QUALITY ASSURANCE SPECIALIST

Conferees:

WKJ PAS/FC1700

